

**REMARKS**

Applicant appreciates the careful examination given to the Application as reflected in the Office Action mailed September 2, 2005. Reconsideration and favorable action in this Application is respectfully requested.

Claims 1-4, 7-15, 42-48 remain pending and rejected in this Application.

Claims 1, 2, 3, 4, 7, 8, 9, 10, 12, 14, 15, 42 and 47 have been amended.

Claims 46 and 48 have been cancelled.

***§112 Rejection***

The Office Action rejects Claims 1-4, 7-15 and 42-48 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

The limitations previously added to Claims 1, 2, 3, 4, 7, 8 and 47 that has been objected to in the Office Action for failing to comply with §112 have been deleted.

Applicant amends Claim 1 to include patentable subject matter for which there is support in the specification. Amended Claim 1 requires the first and second adhesive to be formulated of an invisible adhesive of sufficient strength to cause an unpleasant sticking sensation to pets. The specification provides support for this limitation at page 6, lines 1-5. The subject matter of amended Claim 1 is supported by the specification and not disclosed or made obvious by the art of record; therefore Applicant believes Claim is now in condition for allowance.

Claim 2 has been amended to provide that the gaps on the transfer sheet provide an indication of an edge of the plurality of strips and the bisection of the plurality of the strips. Support in the specification is found at page 5, lines 16-17. It is believed that Claim 2 is now in condition for allowance.

Applicant amends Claim 3 to include patentable subject matter for which there is support in the specification. Amended Claim 3 requires a side margin indicator means for preventing confusion between a bisection cut in the release layers and a side margin by gaps that provide an indication of the side margin of a different character than the bisected layers. The specification provides support for this limitation by disclosing that "Gaps 17 between strips 13 provide an indication of the side margins of each strip 13 so as to not confuse cut 29 with the side margins". Pg. 5, Lns. 16-17. The subject matter claimed in Claim 3 is supported by the disclosure in the specification and is not disclosed or made obvious by the art of record; therefore Applicant believes that Claim 3 is in condition for allowance.

Claim 7 has been amended to clarify that the strip is fairly rigid, rectangular and corrugated plastic. The specification discloses that the substrate (or strip as set out in the Claim) is fairly rigid, while the release layer is composed of paper. Pg. 6, Lns. 9, 11. The specification makes it clear that in this embodiment the rigidity of the strip and release sheet can be different. Additionally, if the transfer sheet is fairly rigid, it is inherent that it cannot allow substantial bending. Therefore, amended Claim 7 is allowable because it complies with the written description requirement of §112.

Claim 8 has been amended to clarify the presence of an indicator means. The basis for this limitation is found at page 5, lines 16-17 of the specification. The objectionable matter has been removed. Claim 8 is now believed to be allowable.

With respect to Claims 9-15, Applicant has amended them to place them in condition for allowance. Amended Claim 9 deletes limitations objected to under § 112. Claim 10 has been amended to add the limitation of a transparent adhesive. Since the specification sets out that the strip in use must be transparent, at page 5, line 24-page 6, line 1, it is clear that the combination

of the adhesive and strip must be transparent. Claim 12 has been amended to add the limitation of an indicator means. Basis for this amendment appears in the specification at page 5, line 16. Claim 15 has been amended to include the limitation of indicator gaps. Support is found in the specification at page 5, line 16.

Claim 42 has been amended to add the limitation that the substrate be substantially flat. Support is found in the drawings at Figs. 4 and 5. Moreover, specification supports the addition of this limitation because it discloses that in this embodiment, the "substrate is fairly rigid". Pg. 6, Ln. 9.

With respect to Claims 43-45, Applicant respectfully asserts that these Claims are patentable because they depend from now allowable Claim 42.

Claim 47 has been amended to add the limitation of an indicator means and supporting limitations. Amended Claim 47 is believed to be allowable because the limitations are not shown or made obvious from the art of record.

### ***§102 (b) Rejection of Claims***

The Office Action conditionally rejects Claims 42 and 43 under 35 U.S.C. §102(b) as being anticipated by *Sekula* if the limitation added to Claim 42 is deleted. Applicant submits that Claim 42 complies with the written description requirement of 35 U.S.C. §112 and that Claim 42 claims subject matter not disclosed or made obvious by *Sekula*. Moreover, *Sekula* does not show or make obvious a substantially flat corrugated substrate.

Since Claim 43 depends from Claim 42, it is also believed to be allowable.

### ***§103(a) Rejection of Claims over Avery Adhesive in light of Kriozere***

The Office Action rejects Claims 1, 3, 4 and 46-48 under 35 U.S.C. §103(a) as being unpatentable over Italian Patent 590,156 (*Avery Adhesive*) in view of U.S. Patent No. 4,348,440

to *Kriozere*. A *prima facie* showing of obviousness cannot be established absent some teaching, suggestion or motivation to support the combination. *Pro-Mold & Toll Co. v. Great Lakes Plastics, Inc.*, 37 U.S.P.Q.2d 1626, 1630 (Fed. Cir. 1996). The Federal Circuit has explained that such teaching, suggestion or motivation may come (1) expressly from the references themselves; (2) from the knowledge of those skilled in the art that certain references, or disclosures in the references are known to be of special interest or importance in the particular field; or (3) from the nature of a problem to be solved, leading inventors to look at references related to possible solutions to the problem. *Id.* However, the teaching, suggestion or motivation to combine the prior art to arrive at the claimed invention *cannot* come from the patent application itself. *ACS Hospital Sys., Inc. v. Montefiore Hospital*, 732 F.2d 1572 (Fed. Cir. 1984). Applicant respectfully traverses the rejection of Claims 1, 3, 4 and 47 under §103 (a) because the Office Action fails to establish sufficient teaching, suggestion or incentive to support the combination of *Avery Adhesive* in light of *Kriozere*.

A teaching, suggestion or motivation to combine *Avery Adhesive* in light of *Kriozere* does not come expressly from the references. *Avery Adhesive* fails to show a bisected release layer as required in Claims 1, 3, 4 and 47. Therefore, the Office Action tries to combine *Avery Adhesive* with *Kriozere* because *Kriozere* shows a bisected release layer. However, the fact that a figure of *Kriozere* shows that the edge of a remaining release layer can be used to align a single sided adhesive strip on a pouch does not provide the motivation to combine *Avery Adhesive* with *Kriozere*. *Avery Adhesive* is directed towards a double sided adhesive tab that is used to hold objects such as photographs when mounting. Pg. 2, ¶ 2. *Avery Adhesive* never teaches or suggests any benefit could be obtained by using a release layer to align the double sided adhesive strip on the photograph. Additionally, unlike *Avery Adhesive*, *Kriozere* uses a single sided

adhesive seal to close the open end of sterilized pouches. Col. 1, Lns. 5-6. The bisected strip in *Kriozere* is used to ensure that when the adhesive strip is *folded* over to seal the sterilized pouch there is adhesive to adhesive contact. Col 2., Lns. 55-60. *Kriozere* never teaches, suggests or provides any incentive that the bisected release layer on the single adhesive strip would have any other benefit except for use in sealing pouches. Therefore neither Applicant nor the Office Action can provide any evidence that the references themselves provide any teaching, suggestion or motivation for their combination.

A teaching, suggestion or motivation to combine *Avery Adhesive* in light of *Kriozere* does not come from the knowledge of those skilled in the art. One of ordinary skill in the art inventing a double sided adhesive strip to deter pets from scratching on furniture should not be charged with the knowledge of combining a reference related to an adhesive strip to mount pictures with a reference related to an adhesive member to sterilely seal a pouch because the only overlap between the three inventions is that they all include the use of adhesives. A general relationship between the field of prior art, such as adhesive tabs, is insufficient to suggest the motivation to combine the references. *Micro Chem. Inc. v. Great Plains Chem. Co.*, 103 F.3d 1538 (Fed. Cir.), *cert. denied*, 521 U.S. 1122 (1997). Therefore, the teaching, suggestion or motivation to combine *Avery Adhesive* in light of *Kriozere* cannot come from the knowledge of those skilled in the art.

A teaching, suggestion or motivation to combine *Avery Adhesive* in light of *Kriozere* does not come from the nature of the problem to be solved by Claims 1, 3, 4 and 47. Claims 1, 3, 4 and 47 are directed towards an invention that deters pets from clawing on furniture or digging in plants. The nature of the problem of deterring pet behavior would not lead an inventor to look at references related to both mounting pictures as in *Avery Adhesive* and sealing sterilized pouches

as in *Kriozere* as possible solutions to the problem needing to be solved because the each reference uses adhesive to solve completely different problems. Therefore, the motivation to combine *Avery Adhesive* in light of *Kriozere* does not come from the nature of the problem to be solved.

The Office Action fails to establish a prima facie case of obviousness to support its rejection of Claims 1, 3, 4, and 47 based on *Avery Adhesive* in light of *Kriozere* because it does not provide any teaching, suggestion or motivation to combine these references that comes from (1) the references themselves, (2) from the knowledge of those skilled in the art or (3) from the nature of the problem to be solved. The only teaching, suggestion or motivation to combine *Avery Adhesive* in light of *Kriozere* to arrive at the invention in Claims 1, 3, 4 and 47 impermissibly comes from the patent application itself. Therefore, Applicant respectfully requests that the rejection of Claims 1, 3, 4, and 47 under §103(a) based on *Avery Adhesive* in light of *Kriozere* be withdrawn.

***§103(a) Rejection of Claims over Avery Adhesive  
in light of Kriozere and further in view of Sato***

The Office Action rejects Claim 2 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Kriozere* as applied to Claim 1 and further in view of *Sato*. Applicant respectfully asserts that amended Claim 2 is patentable and not obvious and because it depends from allowable Claim 1.

***§103 (a) Rejection of Claims over  
Avery Adhesive in view of Anhauser et al.***

The Office Action conditionally rejects Claims 7, 9, and 11-13 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser*. Amended Claim 7 now

complies with the written description requirement of §112. Further, amended Claim 7 includes limitations not shown in nor made obvious from *Avery Adhesive* and/or *Anhauser*.

Since Claims 9 and 11-13 depend from Claim 7, they are also believed to be allowable.

***§103 (a) Rejection of Claims over Sekula in view of Anhauser et al.***

The Office Action conditionally rejects Claims 7, 11, 13-15, 44 and 45 under 35 U.S.C. §103(a) as being unpatentable over *Sekula* in view of *Anhauser*. Claim 7 has been amended to claim patentable subject matter.

Since Claims 11 and 13-15 depend from Claim 7, Applicant also believes these Claims to be allowable.

Claim 42 has been amended and has support in the specification. Applicant submits that neither *Sekula* nor *Anhauser* disclose or suggest a flat substrate.

With respect to Claims 44 and 45 Applicant respectfully asserts that these Claims are patentable and not obvious in light of *Sekula* in view of *Anhauser* because Claims 44 and 45 depend from allowable Claim 42.

***§103 (a) Rejection of Claims over Avery Adhesive in view of Anhauser et al. and further in view of Sato***

The Office Action conditionally rejects Claim 8 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser* as applied to Claim 7 and further in view of *Sato*. However, Applicant asserts that Claim 8 is allowable because the limitation added fully complies with the written description requirement of § 112 and is not shown or suggested by *Avery Adhesive* or *Anhauser*.

***§103 (a) Rejection of Claims over Avery Adhesive  
in view of Anhauser et al. and further in view of Patel et al.***

The Office Action conditionally rejects Claim 10 under 35 U.S.C. §103(a) as being unpatentable over *Avery Adhesive* in view of *Anhauser* as applied to Claim 7 and further in view of *Patel et al.* Claim 10 has been amended to incorporate the limitations of Claim 7 and is now believed to be allowable over the art of record.



**CONCLUSION**

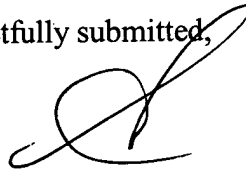
In view of the above, it is submitted that Claims 1-4, 7-15 and 42-45 and 47 are in condition for allowance.

Applicant has properly made a Request for Continued Examination of this Application under 37 C.F.R. §1.114.

Applicant respectfully requests reconsideration of the Application and earnestly solicits allowance. Should it facilitate allowance of the Application, the Examiner is invited to telephone the undersigned attorney.

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Respectfully submitted,



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